

"Brenner '211") or claims 1-132 of Brenner et al., U.S. Patent No. 5,830,068 (hereinafter "Brenner '068"), each in view of Lawler et al., U.S. Patent No. 5,805,763 (hereinafter "Lawler").

These rejections are respectfully traversed.

II. Information Disclosure Statement

On page 2 of the Final Office Action, the Examiner states that the "references listed in the information disclosure statement filed September 23, 2002 ... could not be located" and that applicants should "submit new copies of the foreign patent documents listed on page five of the information disclosure statement." Copies of the previously filed foreign references are submitted herewith. Applicants respectfully request that these references be fully considered and that the Examiner return a signed copy of the previously filed Form PTO-1449.

III. Applicants' Reply To The Double Patenting Rejections

All of the rejections set forth in the Final Office Action are under the judicially-created doctrine of obviousness-type double patenting, analogous to a failure to meet the non-obviousness requirements of 35 U.S.C. § 103 (see MPEP § 804(II)(B)(1)), and are based on combining either the claims of Brenner '211 or the claims of Brenner '068 with Lawler. However, applicants respectfully submit that the rejections fail for the following independent reasons.

A. The Double Patenting Rejection Over The Claims Of Brenner '068 Is Improper Because Brenner '068 Is Statutory Prior Art Under 35 U.S.C. § 102(a)

It is well settled that, in cases where double patenting may be at issue, "it must always be carefully observed that the ... patent [used as the basis for a double patenting rejection] is not 'prior art' under either section 102 or section 103 of the 1952 Patent Act (35 U.S.C. as amended)." In re Boylan, 157 USPQ 370, 375; see also In re Braithwaite, 154 USPQ 29, 34 n.4 ("While analogous to the non-obviousness requirement of 35 U.S.C. § 103, that section is not itself involved in double patenting rejections because the patent principally underlying the rejection is not prior art"). Indeed, the courts have determined that double patenting rejections are reserved for situations "where patents are not citable as a reference against each other and therefore can not be examined for compliance with the rule that only one patent is available per invention." Eli Lilly & Co. v. Barr Labs., 58 USPQ2d 1865, 1866 (Circuit Judge Newman dissenting, in a separate opinion, on the Court's refusal to reconsider the case en banc); see also General Foods Corp. v. Studiengesellschaft Kohle mbH, 23 USPQ2d 1839, 1846.

In the present case, Brenner '068 was filed on September 8, 1995 and issued on November 3, 1998, which is before the date of applicants' claimed invention.* Accordingly, the claims and disclosure of Brenner '068 are statutory prior art under 35 U.S.C. § 102(a). Therefore,

* Applicants' non-provisional patent application was filed on January 30, 2000 and claims priority from U.S. provisional patent application No. 60/142,174, filed July 1, 1999.

the double patenting rejection based on the claims of Brenner '068 is improper and should be withdrawn.* See MPEP § 804.

B. The Obviousness-Type Double Patenting Rejections Should Be Withdrawn Because The Examiner Has Failed To Establish A *Prima Facie* Case Of Obviousness

In addition to the double patenting rejection over the claims of Brenner '068 being improper because Brenner '068 is prior art under 35 U.S.C. § 102(a), the obviousness-type double patenting rejections based on combining either the claims of Brenner '068 or the claims of Brenner '211 with Lawler should be withdrawn because the Examiner has failed to establish a *prima facie* case of obviousness. See MPEP §§ 2142 and 2143.

1. The Combination of References Fails To Show Or Suggest Every Element Of Applicants' Claims

The Examiner concedes on pages 5 and 6 of the Office Action that the claims of Brenner '211, the claims of Brenner '068, and Lawler individually fail to show (a) automatically providing the user with an option to record a race while the user is interacting with a plurality of wager creation options for that race as required by independent claims 1 and 37; and (b) automatically providing the user with an opportunity to record the given race in response to the user placing a wager for the given

* Applicants would like to point out to the Examiner that although Brenner '211 is prior art under 35 U.S.C. § 102(e), and thus may not preclude patentability under 35 U.S.C. § 103(c), the claims of Brenner '211 are fully supported by the disclosure of its parent, Brenner '068, which is prior art under § 102(a).

race as required by claims 19 and 48. Nevertheless, the Examiner states that the combination of the claims of Brenner '211 and the claims of Brenner '068, each with Lawler, when taken as a whole, show these features. Applicants respectfully disagree.

The Examiner's statement is based on the contention that "Lawler suggests to ... automatically provide users the option to record a video program when they select content from an interactive menu" (emphasis added) (page 6 of the Office Action). Contrary to the Examiner's contention, Lawler more narrowly teaches providing users the option to record a video program when they select that video program, not any content, from an interactive program guide menu. Lawler does not teach providing users the option to record a video program when they select any content from any interactive menu. For example, when a user of Lawler selects Remind button 140 of FIG. 6, the user is not provided with an option to record a video program.

Accordingly, the combination of the claims of Brenner '211 and the claims of Brenner '068, each with Lawler, when taken as a whole, fails to show or suggest automatically providing the user with an option to record a race while the user is interacting with a plurality of wager creation options for that race as required by independent claims 1 and 37. Likewise, the combination of the claims of Brenner '211 and the claims of Brenner '068, each with Lawler, when taken as a whole, fails to show or suggest automatically providing the user with an opportunity to record the given race in response to the user placing a wager for the given race as required by claims 19 and 48.

Because the combination of references fails to show or suggest all elements of applicants' claims, the obviousness-type double patenting rejections of independent claims 1, 19, 37, and 48 should be withdrawn. See In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) ("To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art"); see also MPEP § 2143.03. Dependent claims 2-18 and 38-47 are likewise patentable. See In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988) ("Dependent claims are non-obvious ... if the independent claims from which they depend are non-obvious").

2. The Examiner Failed To Provide A Sufficient Motivation For Combining the References

Moreover, assuming arguendo that the combination of the claims of Brenner '211 and the claims of Brenner '068, each with Lawler, shows or suggests all features of applicants' claims, as the Examiner contends, the obviousness-type double patenting rejections should be withdrawn because the Examiner fails to provide a sufficient motivation for combining the references. See In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998) ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references"). See also MPEP §§ 2142 and 2143.01.

Instead of providing the requisite teaching or motivation for combining the references, the Examiner merely concludes that it would have been obvious to combine the claims of Brenner '211 or the claims of Brenner '068 with Lawler "to simplify the recording process thereby increase the quickly and easily designate a video for

recording from an interactive display" (sic). See page 5 of the Final Office Action. This statement, however, is tantamount to saying that it would have been obvious to combine the references to achieve the benefit of applicants' novel approach. But such "[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'" of a motivation to combine. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999); see also MPEP § 2143.

Moreover, the claims of Brenner '068 and the claims of Brenner '211 already specify that races can be recorded. This feature of the claims is illustrated, for example, in FIGS. 48 and 49 where a user may select "other race" menu option 594 (FIG. 48) and be presented with a display which may include "tape/VCR" options 616 and 618 (FIG. 49) for allowing the user to record races. Indeed, the claims of Brenner '068 and the claims of Brenner '211 already include a simplified recording process that allows users to "quickly and easily designate a [racing] video for recording from an interactive display" (see page 5 of the Office Action). Thus, the Examiner's conclusory statement of motivation fails to show or suggest why one of skill in the art would have been motivated to modify the approach already set forth in the claims of Brenner '068 and the claims of Brenner '211 with the disclosure of Lawler to arrive at applicants' claimed approach.

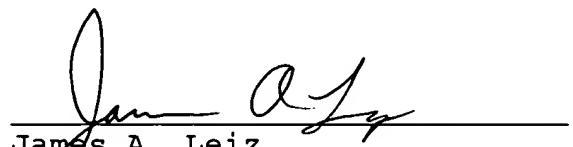
Without a proper motivation for combining the references, the Examiner has "simply take[n] the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability," a practice that is insufficient as a matter of law. In re Dembiczak, 175 F.3d 994, 999. For at least this reason, the obviousness-

type double patenting rejections should be withdrawn. See MPEP §§ 2142 and 2143.

V. Conclusion

The foregoing demonstrates that the obviousness-type double patenting rejections should be withdrawn. This application is therefore in condition for allowance. Reconsideration and allowance of this application are respectfully requested.

Respectfully submitted,



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